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10/018,685	12/20/2001	Jean-Francois Faveraux	034299-374	7788

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EXAMINER

ROBINSON BOYCE, AKIBA K

ART UNIT	PAPER NUMBER
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3628

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/018,685

Applicant(s)

FAVERAUX, JEAN-FRANCOIS

Examiner

Akiba K. Robinson-Boyce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/20/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. Due to communications filed 11/7/06, the following is a final office action. Claim 1 has been cancelled, claims 2-5, 9 and 12 have been amended. Claim 17 has been added. Claims 2-17 are pending in this application and have been examined on the merits. Claims 2-17 are rejected as follows.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 2 recites the limitation "wherein the user programs another parking end time" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 12-16 are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. As per claim 12, this claim recites "A voucher for the payment of parking charges, characterized in that it includes two parts, the first forming a sticker comprising an optical code, the second containing a secret code". However, these two parts merely describe data that is non-functional descriptive data, which makes it difficult for the examiner to determine the operability, and therefore the

usefulness of the invention. For this reason, claim 12, and all claims that depend from it (claims 13-16) are inoperative.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-4, 6, 9-11, 13, 14, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ilen (US 5,905,247), and further in view of Bezin et al (US 4,982,070).

As per claim 17, Ilen discloses:

the user goes to an approved point, (col. 3, lines 34-41, esp lines 38-41, shows registering the start of parking by the driver to a parking fee register by calling a predetermined service number, which in this case, must be approved to be predetermined, also, another phone situated near the parking area can be used and in this case, this phone in the parking area represents the approved point);

at the approved point the user subscribing to a virtual pay and display service, (col. 3, lines 34-37, shows registering the start of parking by the driver to a parking fee register by calling a predetermined service number, which in this case, must be approved to be predetermined and also associated with a particular register, in this case, the point is represented by the location of the GSM mobile phone);

said subscribing step comprising the user completing a subscription form, (Col. 5, lines 16-18, shows subscriber information is maintained in a database at the parking fee register, which implies that the subscriber filled out some type of form or questionnaire to get subscriber information in the database),...

wherein said ID comprises a sticker comprising a portion having an optical code, (Col. 3, line 67-Col. 4, line 1 shows vehicle code is indicated on the sticker in a form readable by machine, w/ Col. 6, lines 31-33, shows a bar code in which vehicle code is read optically, here the user has this vehicle code, and is a subscriber of the system, meaning that upon registration, this code was given to the subscriber),

and a portion having a secret code, (Col. 3, lines 41-42, user [which is also a subscriber] enters a personal code, which means upon subscription to the service, a personal code only known by the user was established),

thereafter the user affixing the portion of the ID having an optical code to the windscreen of said at least one vehicle, (Col. 3, lines 61-64, shows a vehicle code indicated on an identification means such as a sticker attached to the windscreen, since the user is a subscriber, this indicates that the user attached the sticker to the windscreen upon registration similar to when one goes to motor vehicles, upon registration of the car, a sticker is handed to the driver to be affixed to the registered car).

In the instant case, Ilen does not specifically disclose the actual process of subscribing by completing a subscription form, or receiving an ID in the form of a sticker comprising an optical code, and a secret hidden code, however, as described above in

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the rejection, the user is shown to be a subscriber, and that, subscriber information is maintained in a database at the parking fee register in Col. 5, lines 16-18, which implies that the subscriber filled out some type of form or questionnaire to get subscriber information in the database. In addition, Col. 3, line 67-Col. 4, line 1 shows vehicle code is indicated on the sticker in a form readable by machine, w/ Col. 6, lines 31-33, shows a bar code in which vehicle code is read optically. In this case, the user already has this vehicle code in order to be able to enter it, and is also a subscriber of the system, meaning that upon registration, this code was established for the subscriber. The same is applied to the personal code shown in Col. 3, lines 41-42. In addition, Col. 3, lines 61-64, shows a vehicle code indicated on an identification means such as a sticker attached to the windscreen, and again since the user is a subscriber, this indicates that the user attached the sticker to the windscreen upon registration similar to when one goes to motor vehicles, upon registration of the car, a sticker is handed to the driver to be affixed to the registered car).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention for the user to complete a subscription form, and receives an ID in the form of a sticker comprising an optical code and a secret hidden code with the motivation of registering the user in the parking system and providing him with information necessary for accessing the system.

Ilen does not specifically disclose where he provides particulars of bank account, but does disclose automatically charging the driver for parking through the telephone bill of the user of the vehicle in col. 5, lines 5-8.

However, Bezin et al discloses:

where he provides particulars of bank account, (Col. 3, lines 5-14, shows that the driver buys a card [as a subscription to the organization managing the parking spaces], which is provided with a magnetic track that has a particular identification number and a credit balance that corresponds to the amount of paid by the driver when buying the card, since a credit balance exists for the card, the card serves as a portable bank for the customer, and the identification number stored on the magnetic track of the card serves as the account number for the card, and upon using this card, the magnetic strip is read and the identification number or account number for the card or portable bank is provided as shown in col. 3, line 64-col. 4, line 3). Bezin et al discloses this limitation in an analogous art for the purpose of showing that the identification number of the card must be provided in order to complete the process of paying for parking.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to provide the particulars of a bank account with the motivation of supplying information that would help associate a financial account with an account in which a car is registered.

As per claim 2, Ilen discloses:

...accessing the telephone server (15), by keying in its pre-set access number, (col. 3, lines 34-37, driver calls a predetermined service number);

Ilen does not specifically disclose wherein the user programs another parking end time..., but does disclose an indication of the starting time of parking and the remaining parking time in col. 4, lines 62-63.

However, Bezin et al discloses:

wherein the user programs another parking end time, (Col. 8, lines 25-28, means for storing pairs of data items corresponding to the expiry time). Bezin et al discloses this limitation in an analogous art for the purpose of implying a function of prepayment.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to program another parking end time with the motivation of indicating additional information that will help determine the cost of parking in a space.

As per claim 3, Ilen discloses:

wherein the user requests, by mail, certification of his payment, (col. 4, line 64-col. 5, line 8, shows ticket is printed and automatically added to a telephone bill [which is mailed to the customer's address], w/ col. 5, lines 22-30, shows subscriber data includes information needed for charging the subscriber such as a telephone number to the telephone bill of which subscriber fees are added, therefore when a user subscribes, he includes information that triggers the system to mail him a telephone bill with subscriber fees, and since this information is included by the subscriber, this indicates that he subscriber pre-requests the information, which is the same as requesting, only beforehand).

As per claims 4, 13, Ilen discloses:

wherein the optical code is a bar code, (Col. 6, lines 31-33, barcode read optically).

As per claims 6, 14, Ilen discloses:

wherein the sticker a self-adhesive sticker, (Col. 3, lines 63-64, sticker attached to windscreen, since the user is a subscriber, this indicates that the user attached the sticker to the windscreen upon registration similar to when one goes to motor vehicles, upon registration of the car, a sticker is handed to the driver to be affixed to the registered car).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention for the sticker to be self-adhesive with the motivation of having the subscriber mount the sticker on the car as the process is done for the registration of vehicles in motor vehicles.

As per claim 9, Ilen discloses:

wherein the official responsible for verifying the correct payment of the parking charges uses an optical reader to read the optical code applied on the windscreen a vehicle, and wherein this reading is transmitted by means of a mobile telephone to the telephone server which verifies the payment the parking charge for the ID concerned, (Col. 4, lines 31-54, traffic warden uses read head to read vehicle code which activates the predetermined service number).

As per claim 10, Ilen discloses:

wherein a signal emitted by the mobile telephone warns the official in the event of invalid parking, (Col. 4, lines 55-67, control device notifies the traffic warden of information in which he can determine if parking is not paid for or if the maximum parking time is exceeded, where control device has a GSM mobile phone connected to it as shown in col. 4, lines 31-33).

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As per claim 11, Ilen discloses:

wherein the signal emitted is an optical signal or a sound signal, (Col. 4, lines 55-58, control device notifies information to the traffic warden by means of a display screen, indicating that an optical signal was sent to the display).

7. Claims 5, 7, 8, 12, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ilen (US 5,905,247), and further in view of Bezin et al (US 4,982,070), and further in view of Fulcher et al (US 6,505,774).

As per claims 5, 12, Ilen discloses:

...a voucher...in two parts, the first...forming the sticker, the second...containing the secret code/the voucher comprising two parts, the first part...forming a sticker comprising an optical code, and the second part...containing a secret code, (Col. 3, lines 57-63, discloses that the vehicle code is indicated on a sticker and shows the entry of the vehicle code and the personal code [secret code]).

neither Ilen nor Bezin et al disclose wherein the user receives an ID the form of a voucher, but Ilen does disclose the vehicle and personal ids as described above, and in col. 3, lines 59-63.

However, Fulcher et al discloses:

wherein the user receives an ID the form of a voucher, (Col. 21, lines 12-14, vouchers). Fulcher et al discloses this limitation in an analogous art for the purpose of showing that vouchers are indicia of payment for parking).

It would have been obvious to one of ordinary skill in the art to receive an ID in the form of a voucher with the motivation of providing a form indicating a credit against future expenditures in a parking environment.

As per claims 7, 15, neither Ilen nor Bezin et al disclose wherein the sticker is made of a material, such that the user can insert into a transparent pocket fixed on windscreen of a said vehicle, but Ilen does disclose the vehicle and personal ids as shown in col. 3, lines 59-63.

However, Fulcher et al discloses:

wherein the sticker is made of a material, such that the user can insert into a transparent pocket fixed on windscreen of a said vehicle, (Col. 21, lines 12-14, decals). Fulcher et al discloses this limitation in an analogous art for the purpose of showing that decals are indicia of payment for parking).

It would have been obvious to one of ordinary skill in the art wherein the sticker is made of a material, such that the user can insert into a transparent pocket fixed on windscreen of a said vehicle with the motivation of providing a label that is made to be transferred to glass so the id can appropriately be attached to the windshield.

As per claims 8, 16, Ilen, Bezin et al, not Fulcher et al disclose wherein secret code is a secret scratch code on the second part of the voucher, but Ilen does disclose the vehicle and personal ids as shown in col. 3, lines 59-63.

However, Official notice is taken that it is old and well known in the voucher art for the secret code to be a secret scratch code. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention for the secret code to be a

secret scratch code with the motivation of providing the code without displaying it to anyone but the user who scratches the code off of the voucher.

Response to Arguments

Applicant's arguments, see the arguments, filed 11/7/06, with respect to claims 1-11 have been fully considered and are persuasive. The 35 USC § 112 rejection of claims 1-11 has been withdrawn.

Applicant's arguments filed 11/7/06 have been fully considered but they are not persuasive.

As per claims 12-16, the applicant argues that the examiner has the initial burden to show that one of ordinary skill in the art would reasonable doubt the asserted utility, and that the examiner has provided no evidence showing that one of ordinary skill in the art would reasonably doubt the asserted utility of the claimed voucher. The Applicant disagrees that the two parts of the claimed voucher "merely describe data that is non-functional descriptive data", and also argues that the claims, which are dependent from claim 12 speak of the optical code and the secret code in specific and concrete terms. However, independent claim 12, and all claims that depend from it (claims 13-16) still lack utility since the claim does not show how the voucher is used. One can not just claim a voucher without further claiming how one would put it to use. Even though dependent claims recite a bar code, etc, by reading the claims, one would not know what the bar code is being used for.

As per claims 1-4, 6, 9-11, 13, 14, and 17, applicant argues that the examiner's contention that in Ilen, "subscriber information is maintained in a database at the

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parking fee register in Col. 5, lines 16-18, which implies that the subscriber filled out some type of form or questionnaire to get subscriber information into the database”.

Applicant argues that data could have just as well entered data via a computer connected to the internet, in which case the user would not have received an ID at the approved point. However, arguments are moot with respect to claim 1, since this claim has been cancelled. In addition, even in the case where a user enters data via a computer connected to the internet, it is common for a user to log into a computer using a login ID, the computer recognizes the user by this ID, and this ID is used for the user to gain use of the computer, and along with a password, is approved for use of a computer. In this case, on the computer end, the user receives a specific ID for use of the computer, which is approved since the ID and password must match for use with that particular computer.

As per claim 17, applicant argues that Ilen does not suggest that the user provides particulars of the user's bank. Applicant also argues that Bezin et al does not cure the deficiencies of Ilen, and argues that in Bezin et al, the driver apparently pays cash to a parking attendant or to a machine located at the organization managing the parking space. However, the combination of Ilen and Bezin et al discloses providing the particulars of a bank account. Specifically, in col. 3, lines 5-14, the driver buys a card, and uses that card to pay for parking fees. The card has a credit balance which corresponds to the amount of paid by the driver when buying the card as shown in col. 3, lines 12-15. Since a credit balance exists for the card, the card serves as a portable bank for the customer, and the identification number stored on the magnetic track of the

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card serves as the account number for the card, and upon using this card, the magnetic strip is read and the identification number or account number for the card or portable bank is provided.

Applicant also argues that it would not be obvious to combine the teaching of Ilen with the teachings of Bezin. However, both references disclose parking payment systems where payment information on the vehicles are maintained and managed.

As per claims 5, 7, 8, 12, 15 and 16, the applicant argues that Ilen does not teach or suggest the Applicant's claimed voucher having two parts, a sticker with an optical code and a second part with a secret code, and merely teaches the entry of certain data, not applicant's claimed voucher or ID. However, Col. 3, lines 57-63 of Ilen discloses that the vehicle code is indicated on a sticker (which is optical since it is visually indicated), and shows the entry of the vehicle code and the personal code [secret code] for the use with paying parking fees. Ilen does not specifically disclose a voucher, but in this case the sticker serves as a voucher since it is no more than a document that gives evidence of an expenditure, such as parking. In combination with Fulcher et al, the voucher of the present invention is disclosed. In Col. 21, lines 12-14, Fulcher et al discloses vouchers as indicia of payment for parking. Fulcher et al was combined to specifically show that a "voucher" is used for payment of parking.

For the reasons stated above, claims 2-17 remain rejected.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Akiba K Robinson-Boyce whose telephone number is 571-272-6734. The examiner can normally be reached on Monday-Friday 9am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7238 [After final communications, labeled "Box AF"], 703-746-7239 [Official Communications], and 703-746-7150 [Informal/Draft Communications, labeled "PROPOSED" or "DRAFT"].

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

A handwritten signature in black ink, appearing to read 'Akiba K Robinson-Boyce'.

A. R. B.

December 29, 2006